

## REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application.

### Amendments to the Specification

The specification has been amended to provide patent numbers and filing dates. No new matter has been added.

### Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-8, 12-20, 24-27 and 29-31 were rejected as being anticipated by U.S. Patent No. 5,848,410 issued to Walls, et al. (*Walls*). Claims 26, 27 and 29 have been canceled. Thus, the rejection of claims 26, 27 and 29 is moot. For at least the reasons set forth below, Applicants submit that claims 1-8, 12-20, 24, 25, 30 and 31 are not anticipated by *Walls*.

Applicants' claim 1 recites the following:

generating, automatically with an electronic device, a local network search request in response to an original search request, the local network search request to cause a search to be performed on electronic documents unconsciously captured by a local network device, wherein the unconsciously captured documents are stored by a device that is part of a local network, the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request; and

generating, automatically with the electronic device, an external network search request in response to the original search request, the external network search request to cause a search to be performed on electronic documents available from devices that are part of an external network via a network portal of an external network according to the search parameters of the original search request.

Thus, Applicants claim two searches in response to a single, original search request. *The first search is of unconsciously captured documents on a local network device and the*

*second search is performed via a network portal of an external network.* Claim 13 is directed to a machine readable medium and recites similar limitations. Claim 25 is directed to a device to automatically capture documents and an application to search the captured documents as well as generate a search request for external documents.

*Walls* discloses:

To improve access to documents in a large database, such as the World Wide Web of the Internet *or* a group intranet...

See Abstract (emphasis added). Thus, *Walls* suggests an indexing and searching either an external network *or* an internal network (whether or not unconsciously captured documents), *but not both and external network and unconsciously captured documents on a local network* in response to a single search request.

The indexing system of *Walls* can indicate whether an indexed document is “remote” or “local.” See col. 19, lines 5-10. However, *Walls* does not disclose or suggest searching both remote and local sources in response to a *single* (original) search request. More specifically, *Walls* does not disclose generating two search requests, one for unconsciously captured documents on a local network device and another for a network portal of an external network

With respect to unconscious capture, the Specification states:

Unconscious capture is an operation in which a device ... requests an archiving device ... to archive a document. In general, unconscious capture refers to FMA 150, or other device, automatically capturing documents processed by network 100 or devices coupled to network 100 without user intervention.

See page 13, lines 2-6.

The Final Office Action states:

*Walls* teaches...unconsciously captures (see col.12 lines 57-67 to col.13 lines 1-4) by a local network device (see col.10 lines 15-16: output

devices), the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request (see col.11 lines 25-39)...

See pages 2-3. However, the passage from col. 12 line 57 to col. 13, line 4 of *Walls* discloses extraction of header information from a file being indexed. ***Nothing in the passage discloses capture of the electronic document.*** Moreover, *Walls* does not disclose any document capture technique equivalent to unconscious capture. Therefore, *Walls* does not anticipate the invention as claimed in claims 1, 13 and 25.

The Final Office Action states:

...Walls teaches that the "indexer is configured to search one **or more** files (1, 2, 3, ...n files) within **at least** one file system ("remote" or "local") at one **or more** intervals (first, second, third, ... $\infty$ )" (see col. 3 lines 52-54 and col. 26 lines 25-26).

See page 7 (emphasis original). However, *Walls* discloses that "the at least one file system includes files in a network." See col. 4, lines 20-22. ***Thus, Walls discloses that the one or more file systems refers to a single network.*** Therefore, *Walls* does not disclose search requests for a local network and an external network in response to a single search request.

Claims 2-8 and 12 depend from claim 1. Claims 14-20 and 24 depend from claim 13. Claims 26-31 depend from claim 25. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-8, 12, 14-20, 24 and 26-31 are not anticipated by *Walls* for at least the reasons set forth above.

#### Claim Rejections - 35 U.S.C. § 103(a)

Claims 9 and 21 were rejected as being unpatentable over *Walls* in view of U.S. Patent No. 6,088,675 issued to MacKenty, et al. (*MacKenty*). Claim 9 depends from claim 7, which depends from claim 1 and adds the limitation that a search report is

generated using XML. Similarly, claim 21 depends from claim 19, which depends from claim 13 and adds the limitation that a search report is generated using XML. Thus, the remarks above with respect to claims 1 and 13 apply to claims 9 and 21 as well.

*MacKenty* discloses converting speech and non-speech sounds to SGML/XML documents. See Abstract. Thus, *MacKenty* does not teach *search reports* being generated using XML. Furthermore, even if *MacKenty* did disclose generating search reports using XML, *MacKenty* does not cure the deficiencies of *Walls*. Therefore, no combination of *Walls* and *MacKenty* teaches or suggests the invention as claimed in claims 9 and 21. For at least the foregoing reasons Applicants submit that no combination of *Wallsy* and *MacKentry* teaches or suggests the invention as claimed in claims 9 and 21.

Claims 10, 11, 22 and 23 were rejected as being unpatentable over *Walls* in view of U.S. Patent No. 5,913,040 issued to Rakavy, et al. (*Rakavy*). Claims 10 and 11 depend from claim 7, which depends from claim 1. Claims 22 and 23 depend from claim 19, which depends from claim 13. Thus, the remarks above with respect to claims 1 and 13 apply to claims 10, 11, 22 and 23 as well.

*Rakavy* is cited to teach a search report having an advertisement selected based on the search results. However, *Rakavy* is not cited to teach, nor does *Rakavy* teach or suggest searching local and external networks as claimed. Therefore, *Rakavy* does not cure the deficiencies of *Walls*. Thus, no combination of *Walls* and *Rakavy* teaches or suggests the invention as claimed in claims 10, 11, 22 and 23.

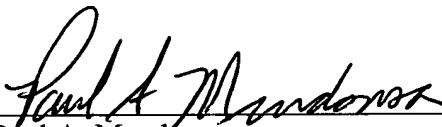
Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-25, 30 and 31 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Should any extension of time fees be necessary please charge our Deposit Account number 02-2666.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: MAY 28, 2003

  
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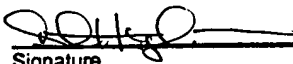
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